

International **Comparative** Legal Guides



Designs **2021**

A practical cross-border insight into designs law

First Edition

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International Comparative Legal Guides

Designs 2021

First Edition

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India

1 Relevant Authorities and Legislation

1.1 What is the relevant Design authority in your jurisdiction?

The design authority in India is the Office of Controller General of Patents, Design and Trademarks. Headquartered in Kolkata, the other branches of the Indian Patent Office are located in Chennai, Delhi and Mumbai. There is only one branch for the Indian Design Office which is located in Kolkata and accordingly, design applications filed in the other three offices are sent to Kolkata for further processing.

1.2 What is the relevant Design legislation in your jurisdiction?

The design legislation presently in force in India is the Designs Act 2000 in accordance with the Designs Rules 2001.

2 Application for a Design

2.1 What can be registered as a Design?

As per Indian designs law, a “design” is defined as “the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two-dimensional or three-dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye”. A “design” does not include any mode or principle of construction or anything which is in substance a mere mechanical device. Thus, any trademark or property mark as defined under Section 479 of the Indian Penal Code, 1860 or any artistic work as defined in Clause (c) of Section 2 of the Copyright Act, 1957 does not fall under the scope of design.

In order to protect a design it must be new and original. “New” in this context means that the subject design must not have been previously published anywhere in India or any other country in a tangible form or by use or in any other way. “Original” implies that the design should originate from the author of the design, but

as a matter of fact, old designs which are new in terms of application are also considered “original”.

Indian designs law protect any new and original design which is capable of being applied to an article. The feature becomes eligible for registration, provided that:

- it is new or original;
- it has not been disclosed by prior publication or use or in any other way;
- it is sufficiently distinguishable from known designs or their combination; and
- it contains no scandalous or obscene matter and is not contrary to public order or morality.

2.2 What cannot be registered as a Design?

Under the Indian designs law, a design cannot be registered which:

- is not new or original;
- has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration;
- is not significantly distinguishable from any known designs or a combination of known designs;
- comprises or contains scandalous or obscene matter;
- includes any mode or principle of construction or operation or anything which is in substance a mere mechanical device; or
- is a trademark, property mark or an artistic work.

2.3 What information is needed to register a Design?

Under Indian designs law, the following information is required to register a design:

- name, address and nationality of the Applicant;
- title and nature of article;
- class and subclass under the Locarno classification;
- priority details and a certified copy of the Priority document along with an English translation in case the priority is claimed; and
- a simply signed General Power of Attorney in original signed by the authorised signatory of the Applicant (no notarisation and legalisation is required).

2.4 What is the general procedure for Design registration?

As per the procedure of the Indian Design Office, once a design application is filed, it is examined, and a First Examination Report is issued within one month from the date of filing the application. In case no objections are raised by the Design Office, the design will be accepted and a Registration Certificate will be issued within two to three months. In case of objection, a response to the examination report should be filed within six months from the filing date. An extension of three months' time beyond the six month due date is obtainable by making a request with official fee prior to the expiry of the said due date. In case any objection is still pending, the Design Office may call for a personal hearing to discuss and comply with the pending issues, if any. If all the objections are addressed in the response to the examination report to the satisfaction of the Controller/ Examiner, the application will be accepted within six months from the date of filing and a Certificate of Registration will be issued within six to 10 months from the date of filing.

2.5 How is a Design adequately represented?

The Indian Design Office prefers seven photographic views of the design, namely: perspective view; front view; back view; top view; bottom view; left view; and right view, or drawings in clear solid lines without any extraneous matter in the background.

2.6 Are Designs registered for specific goods or products?

Yes, designs are registered for specific products. A design may be registered in respect of any or all of the articles prescribed in the class of articles under the Locarno classification.

2.7 Is there a "grace period" in your jurisdiction, and if so, how long is it?

Under Indian designs law, a six-month grace period is available, but that is limited to the disclosure made in a notified exhibition or trade show and where a prior notice of such public disclosure is given to the Controller of Designs in India. The prior publication without notification to the Controller of Designs would hit the novelty of the proposed Indian design application and the grace period will not be available.

2.8 What territories (including dependents, colonies, etc.) are or can be covered by a Design in your jurisdiction?

The statutory rights in a registered design in India extend only within the Indian Territory.

2.9 Who can own a Design in your jurisdiction?

Any person claiming to be the proprietor of any new or original design may apply for design registration. Apart from a natural person, any company or association or body of individuals, whether incorporated or not, or society, or partnership firm can also own a design in India.

2.10 How long on average does registration take?

It takes around three to four months for a design to be registered if no objections are raised. In case an Examination Report is issued, a response needs to be filed within six months and in such case it takes 10–12 months for a design to be registered.

2.11 What is the average cost of obtaining a Design in your jurisdiction?

It depends upon several factors such as if there are objections or a need for a hearing in the case of a prosecution of an application. However, the average cost of obtaining a design registration in India is between USD 400 to USD 700.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, in India there is only the sole route to register a design.

2.13 Is a Power of Attorney needed?

Yes, a Power of Attorney (PoA) is needed in favour of the applicant for filing a design application.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No legalisation or notarisation of the PoA is required.

2.15 How is priority claimed?

As India is one of the countries party to the Paris Convention, therefore, the provisions for the right of priority are applicable. In order to claim priority in India, the Applicant is required to file the design application within six months from the date of convention filing. Such an application must include filing details of basic priority application. The Applicant is required to submit the certified copy of the priority document along with its verified English translation if the priority is not in the English language along with the Indian design application, or the same can be filed within a period of three months from the date of filing with additional fees.

2.16 Can you defer publication of Design applications in your jurisdiction? If so, for how long?

No, it is not possible to defer publication of an application by filing a request with the Design Office. Deferment of design is possible only by delaying the process of design application in the examination stage. The design is published within 15 days after the design is accepted. After the publication, it is open to the public and cannot be kept as a secret.

3 Grounds for Refusal

3.1 What are the grounds for refusal of registration?

The grounds for refusal of design registration are:

- a) that the design is not new or original;
- b) that has been disclosed by prior publication or use or in any other way;
- c) that it is not sufficiently distinguishable from known designs or their combination;
- d) that it is not a design under the Act; and
- e) that it contains scandalous or obscene matter and is contrary to public order or morality.

3.2 What are the ways to overcome a grounds objection?

The applicants should follow the procedural requirements carefully, as most Indian design applications are rejected on procedural issues such as filing of priority documents, POA, clear representation sheets etc., while very few rejections are due to a lack of fulfilment of substantive criteria. Thus, it is important to ensure that both the application form and the representation sheet comply with the guidelines so that design applications are processed speedily and efficiently.

The substantive grounds refusal such as prior publication can be overcome by highlighting the difference between prior designs and designs applied for registration and for other objections, the applicant needs to file a specific reply depending upon the facts and merits of each objection.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any person aggrieved from the order passed by the Controller of Designs, Design Office, India, has a right to appeal before the Calcutta High Court within three months from the date of the order of refusal.

3.4 What is the route of appeal?

The route of appeal will be from the Controller's decision to the High Court.

4 Opposition

4.1 Can a Design application be opposed, if so, on what grounds?

Under the Indian designs law, there is no provision to file an opposition against a Design Application. However, it can be cancelled as described under section 7.

4.2 Who can oppose the registration of a Design in your jurisdiction?

There is no provision for opposition action under Indian designs law as there is only a cancellation procedure.

4.3 What is the procedure for opposition?

Indian designs law does not have the provision to file opposition. However, it can be cancelled as described under section 7.

5 Registration

5.1 What happens when a Design is granted registration?

When an application for registration of a design is in order, it is accepted and registered and then a certificate of registration is issued to the applicant. It is advisable that the applicant must mark the articles on which the design is applied with a sign saying "REGD." or "REGISTERED", with or without the registration number to notify the public that the design is registered. The registration of a design confers upon the registered proprietor "Copyright" on the design for the period of registration. It allows the proprietor of the design to prevent others from producing, importing, selling, or distributing products from having an identical appearance or a fraudulent or obvious imitation.

5.2 From which date following application do an applicant's Design rights commence?

The rights originate from the date of Indian design application or the priority date under the Paris Convention.

5.3 What is the term of a registered Design right?

The term of protection of a design is 15 years subject to renewal before the expiry of an initial term of 10 years from the date of filing/priority date.

5.4 How is a Design renewed?

An application for extension of copyright (Form-3) along with prescribed fees shall be filed with the Design Office before the expiry of the original period of 10 years.

6 Registrable Transactions

6.1 Can an individual register the assignment of a Design?

Yes, an individual can register the assignment of a design.

6.2 Are there different types of assignment?

According to Indian designs law, the right in a registered design can be transferred by way of assignment. There are no different types of assignment. An application in Form-10, with prescribed fees in respect of one design and appropriate fees for each additional design, for registration of the transfer documents is required to be made by the beneficiary to the Controller within six months from the date of execution of the instruments or within a further period not exceeding six months in aggregate. An original/notarised copy of the assignment deed is required to be enclosed with the application.

6.3 Can an individual register the licensing of a Design?

Yes, an individual can file for registration of licensing of a design in the Register of Design. Only a registered licence in respect of a registered design is admissible as evidence before the courts or

in any other proceeding, and therefore such instrument must be registered with the Design Office.

6.4 Are there different types of licence?

Yes, a licence can be exclusive or non-exclusive. A licence is only valid if it is in the form of a written instrument containing detailed terms of the licensing arrangement.

6.5 Are there any laws which limit the terms upon which parties may agree a licence?

No, there are no laws which limit the terms upon which parties may agree a licence.

6.6 Can Designs be the subject of a compulsory licence (or licences of right), and if so, in what circumstances does this arise and how are the terms settled?

Design cannot be the subject of a compulsory licence.

6.7 Can a Design licensee sue for infringement?

No, only the registered proprietor may institute proceedings for design infringement.

6.8 Are quality control clauses necessary in a licence?

A licence agreement needs to be in the form of a written instrument containing all the terms and conditions governing a party's rights and obligation and therefore quality control clauses are advisable.

6.9 Can an individual register a security interest under a Design?

No, a design can be registered as a security interest under the Indian designs law.

6.10 Are there different types of security interest?

Yes, a security interest can include the right, title and interest of any kind whatsoever upon property (which includes designs) created in the favour of a secured creditor and includes any mortgage, charge, hypothecation or assignment.

7 Invalidity

7.1 What are the grounds for invalidity of a Design?

Any interested person may file a petition for cancellation of a registered design at any time after the registration with the controller on one of the following grounds:

- the design has been previously registered in India;
- the design has been published in India or in any other country before the date of registration;
- the design is not a new or original design;
- the design is unregistrable under the act; or
- the design is not a "design" as defined under Section 2(d) of the act.

7.2 What is the procedure for invalidation of a Design?

Under Section 19 of the Design Act 2000, a registered design can be cancelled at any time after the registration of the design, by filing a petition for cancellation in Form 8 with prescribed fee to the Controller of Design. On receipt of a petition for cancellation, the Design Office sends a copy of the petition and the evidence filed to the registered owner. Thereafter, the registered owner files a counterstatement and evidence at the Design Office and delivers a copy to the petitioner. After receipt of the counterstatement and evidence, the petitioner may file its reply statement and evidence by way of affidavit. A hearing is fixed and, after hearing the parties, the controller rules on the petition and issues an order.

7.3 Who can commence invalidation proceedings?

Only an aggrieved person can institute invalidation proceedings.

7.4 What grounds of defence can be raised to an invalidation action?

The ground of prior publication and lack of novelty can be overcome by highlighting the difference between prior designs and registered designs and for other grounds, the registered proprietor may prepare for its defence depending upon the facts and merits of each grounds.

7.5 What is the route of appeal from a decision of invalidity?

An aggrieved person from the order of the Controller of Designs may file an appeal to the High Court, Kolkata, within three months of the date of the order of the Controller.

8 Design Enforcement

8.1 How and before what tribunals can a Design be enforced against an infringer?

A registered owner can file an infringement suit. A registered design in India can be enforced by way of a civil action. The remedies against infringement include interim and permanent injunctions, as well as damages. A civil action enforcing a registered design can be filed before the district court where the defendant resides or conducts business or where infringement has taken place.

8.2 Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

In addition to using the defence of non-infringement in a civil suit, the infringer can use the defence of invalidity of the design on the grounds that the design lacks novelty, is indistinguishable from a known design or contains scandalous matter. If the defence of invalidity is used in a civil action, the district court no longer has jurisdiction and the suit is transferred to the high court with jurisdiction over that district court. However, the registered design can only be cancelled by filing a cancellation petition with the Design Office.

8.3 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedure in a civil suit comprises several stages which are preceded by the filing of the suit (plaint) before the appropriate court. This court could be the State's District Court or High Court (based on original jurisdiction). The stages of civil suit until trial are explained and jotted down below:

- **Stage 1:** Admission of suit and hearing on *ex parte* injunction application. The filed suit is accompanied with an interim injunction application under Order 39 Rules 1 and 2 seeking *ex parte* interim relief.
For the first hearing, the Court reviews the grounds of injunction pleaded in the suit and interim injunction application. If the Court decides that the Plaintiff has made a suitable case for the grant of an interim injunction and the balance of convenience is in favour of the Plaintiff, it passes an *ex parte* injunction order and simultaneously issues court summons to the Defendant for appearance in further hearings and to file its written statement within the stipulated timeline.
In case the Court decides against passing an *ex parte* injunction order and it deems that it is necessary that the Defendant be present in the Court to defend its claims, the Court issues a court summons to the Defendant for appearance in further hearings and to file its written statement within the stipulated timeline.
- **Stage 2:** Service of court summons on the Defendants. The Plaintiffs and Court's Registry are mandated to serve copies of plaint, supporting exhibits alongside the Court's order upon the Defendant's postal and courier services as well as electronic communication in the form of emails, as compliance under Order 39 Rule 3.
- **Stage 3:** Appearance of the Defendant and filing of its written statement. The Defendant is allowed a period of a few weeks or months upon service of court summons to file its written statement in its defence and enter appearance on the second court hearing. The Defendant generally at this stage also files a response to the Plaintiff's interim injunction application under Order 39 Rules 1 and 2. In cases where an *ex parte* injunction order has been passed against the Defendant, the Defendant is at the liberty to file an application seeking vacation of interim injunction order under Order 39 Rule 4.
- **Stage 4:** Filing of reply, rejoinder and replication by parties involved. Both sides have equal opportunity to file responses to the applications filed by the other side. For example, the Plaintiff can file replication to the written statement filed by the Defendant, can file a response or reply to the Defendant's application seeking vacation of interim injunction order and can file rejoinder to its interim injunction application under Order 39 Rules 1 and 2.
- **Stage 5:** The Court decides the Plaintiff's application for grant of interim injunction based on contentions put forth by both sides.
- **Stage 6:** Admission/Denial of documents filed by both sides.
- **Stage 7:** Framing of issues by the Court.
- **Stage 8:** The Plaintiff files its evidence under Affidavit and provides a list of witnesses. Thereafter, trial begins i.e. exhibiting documents filed by the Plaintiff, and cross-examination of its witnesses by the Defendant. The next step involves the same procedure for the Defendant and a cross-examination of its witnesses.

Final arguments are followed by the Court's judgment.

It generally takes anywhere between two to four years and in some cases more than this for proceedings to reach trial from the commencement of a civil suit.

8.4 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary/interim and final injunctions are available. The purpose of a preliminary injunction is to ensure protection of right of the parties on the basis of three factors: *prima facie* case; balance of convenience; and irreparable injury. In order to obtain a preliminary injunction, the plaintiff must prove a *prima facie* case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of a grant of injunction. Final injunctions are granted after the full trial of the case and hearing both the parties on the merits of the suit.

8.5 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, the party can be asked to file relevant documents or the materials as the court may direct to file such documents.

8.6 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The submissions or evidence are presented in writing and also argued orally during the court proceedings. The cross-examination of witnesses is a standard practice in civil suits in India.

8.7 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The invalidity of design registration can only be decided by the IP Office and there is no provision for stay of infringement proceedings pending resolution of invalidity of the design. However, it is important to note that in a civil suit, every ground on which the registration of a design may be cancelled shall be available as a ground of defence.

8.8 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

A registered design in India can only be enforced by way of a civil action and there are no alternative procedures available to enforce such rights in India. However, before approaching the courts, the right holders may explore sending a cease-and-desist notice to infringers and it is more frequent that the infringers do decide to comply with the demands of right holders.

8.9 Who is permitted to represent parties to a Design dispute in court?

The Indian Advocates registered with Bar councils can only represent parties in a design dispute in court.

8.10 After what period is a claim for Design infringement time-barred?

After three years from the last act of infringement, a claim for design infringement becomes time-barred.

8.11 Are there criminal liabilities for Design infringement?

No, the registered design can be enforced by way of civil actions only. There are no criminal liabilities.

8.12 If so, who can pursue a criminal prosecution?

Criminal prosecution is not available in design infringement.

8.13 What, if any, are the provisions for unauthorised threats of Design infringement?

Yes, there are statutory provisions under designs law which deal with the remedies in case of groundless threats of legal proceedings. The court has the power to grant relief in cases of groundless threats of design infringement proceedings. The person aggrieved by a groundless threat may bring a suit praying for the following relief:

- a declaration to the effect that the threats are unjustifiable;
- an injunction against the continuance of the threats; and
- such damages, if any, as he has sustained thereby.

9 Defences to Infringement

9.1 What grounds of defence can be raised by way of non-infringement to a claim of Design infringement? For example are there “must match” and/or “must fit” defences or equivalent available in the jurisdiction?

A suit for infringement may be defended on the grounds that the defendant's design is not similar to the Plaintiff's design and/or it was used prior to the Plaintiff's design. In deciding whether there is any similarity or not between the Plaintiff's design or defendant's design, the legal test is to check for “fraudulent or obvious imitation” in the accused design *vis-à-vis* the registered design. This means the infringing design need not necessarily be identical to the registered design, even some variation which is not substantial enough to differentiate the accused design from the registered design can amount to infringement. Every resemblance does not seem to be the action of infringement or imitation. An obvious imitation is one where it is immediately obvious that another design is so similar to the original registered design, that it is almost impossible to differentiate. The two products need not be placed side by side, but rather examined from the point of view of a customer with average knowledge and imperfect recollection.

9.2 What grounds of defence can be raised in addition to non-infringement?

In addition to using the defence of non-infringement, the infringer can use the defence of invalidity of the design on the grounds that the Plaintiff's design lacks novelty, is indistinguishable from a known design or contains scandalous matter. The following defences are available:

- the design has been previously registered in India;
- the design has been published in India or in any other country before the date of registration;
- the design is not a new or original design;
- the design is unregistrable under the act; or
- the design is not a “design” as defined under Section 2(d) of the act.

9.3 How does your jurisdiction deal with Design protection for spare parts?

According to the Indian Designs Act, a part of an article is registrable provided that it is capable of being made and sold separately. If the spare part has aesthetic appeal and it is capable of being made and sold separately, it can be registered as a design in India.

10 Relief

10.1 What remedies are available for Design infringement?

The remedies against infringement include interim and permanent injunctions, as well as recovery of damages and compensation and cost towards legal fees. A civil action enforcing a registered design can be filed before the district court where the defendant resides or conducts business or where infringement has taken place.

10.2 Are damages or an account of profits assessed with the issues of infringement/validity or separately?

The damages or the account of profits are assessed along with any infringement issues. Damages suffered by the Plaintiff as a result of infringement are recoverable. Attorneys' fees are also recoverable. Where any ground on which the registration of a design may be cancelled is availed as a ground of defence in any suit or other proceeding, the suit/proceedings shall be transferred by the Court in which it is pending, to the High Court for a decision. Defendants may also claim compensation due to loss suffered by them on account of an injunction, if it transpires subsequently that the Plaintiff's rights are invalid.

10.3 On what basis are damages or an account of profits assessed?

Depending on the loss assessed to have been suffered by the plaintiff due to the infringement and/or the flagrancy of the defendant's conduct, the damages are assessed. In case of piracy of a registered Design, a suit for injunction and/or recovery of damages may be instituted against the accused in any court not below the Court of the District Judge. Any of the remedies as prescribed below can be sought against the accused:

- paying to the registered proprietor of the design a sum not exceeding 25,000 rupees recoverable as a contract debt provided that the total sum recoverable in respect of any one design shall not exceed 50,000 rupees; or
- recovery of damages for any such contravention, and an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly.

10.4 Are punitive damages available?

Yes, punitive damages are available depending upon the flagrancy of the conduct of the defendant and the nature of violation and/or whether the defendant is a habitual/repeat offender, in addition to the actual damages established from the evidence filed by the successful party.

10.5 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, the costs are recoverable from the losing party. The court examines and must be satisfied that there is a *bona fide* dispute raised by the plaintiff and that there is a strong case made for trial which needs investigation and a decision on merits; and that there is a possibility of the plaintiff being entitled to the relief claimed by it. However, actual recovery of costs depends upon several factors such as intention of the parties, quantum of loss, merits of the case and evidence submitted before the Court etc. and the Indian courts are not normally liberal in this respect.

11 Appeal

11.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Yes, generally an appeal is on a point of law; however, an appeal may be based on a mixed question of facts and law. An appeal shall lie to the High Court and if the suit has been tried before the High Court then an appeal can be filed before the division bench of that High Court.

11.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be adduced in the following situations:

- if the court or tribunal from whose order the appeal is preferred has refused to admit evidence which it ought to have admitted;
- if the party seeking to adduce the evidence establishes that such evidence was not within its knowledge or could not be obtained despite due diligence and efforts; or
- if the appellate court requires any document to be produced or any witness to be examined to enable it to pronounce the judgment.

12 Border Control Measures

12.1 Is there a mechanism for seizing or preventing the importation of infringing articles and, if so, how quickly are such measures resolved?

The Indian Customs Act, 1962 prohibits the import of goods that infringe intellectual property. The Government of India has enabled IP owners to enforce their IP Rights at Indian Borders under Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007. Under the rules, an IP Rights holder may give notice to the Customs Commissioner requesting the suspension of clearance of goods suspected to be infringing the product. Such notice is registered or rejected within 30 working days from the date of receipt of the notice. In the case where the notice is registered, the minimum validity period shall be one

year unless the rights of the holder request a shorter period of customs assistance or action. The Customs department may, *ex officio*, suspend the clearance of the alleged infringing articles or give a notice if the department has *prima facie* evidence or reasonable grounds to believe the goods are counterfeit/infringing in nature. The rights holder is also required to issue a bank guarantee and furnish a bond. The customs department is under a duty to inform the rights holder immediately about the suspension of clearance of goods, with the reasons for such suspension. Goods whose clearance is suspended are to be released on notice within 10 days (extendable to a further 10 days), when the rights holder fails to join proceedings, or on the department's own initiative within five days, when the rights holder fails to give notice or fails to fulfil the obligation to execute a bond.

The Customs department is authorised to seize and confiscate goods where it has reason to believe the goods are infringing IP Rights and are thus liable to be confiscated under the Customs Act. In case the Customs department determines that the goods detained or seized have infringed IP Rights and have been rightly confiscated under section 111(d) of the Customs Act 1962, the department shall destroy such goods under official supervision or dispose of them through the normal channels of commerce after obtaining no objection from the rights holder.

13 Other Related Rights

13.1 To what extent are unregistered Design rights enforceable in your jurisdiction?

Unregistered designs are not enforceable *per se* and there is no right in or remedy available for unregistered designs under Indian designs law (Designs Act, 2000). However, similarly to trademarks, an unregistered design may be protected under the common law tort of passing off, if it has become distinctive due to long and continuous use. In order to claim such remedy, the design owner must establish that the design had become distinctive in respect of such goods due to long and continuous use. Designs may also be protected under the Copyright Act, 1957 if such design is not registered under the Designs Act. However, in such cases protection is limited and expires once the design has been applied to an article more than 50 times by an industrial process.

The unregistered design has no statutory protection and is susceptible to copying. Thus, it is advisable to obtain design protection to ensure adequate and effective protection.

13.2 What is the term of unregistered Design rights enforceable in your jurisdiction?

There is no term specified as “unregistered designs”, as the same are not enforceable under the Indian designs law (Designs Act, 2000).

13.3 What, if any, are the key differences between unregistered and registered Design rights in your jurisdiction?

An unregistered design does not enjoy statutory design protection and a registered design owner gets the right to file an infringement suit and protect its rights against any third-party use.

13.4 If unregistered Design protection is available in your jurisdiction, is protection cumulative or mutually exclusive?

In unregistered designs, copyright protection is mutually

exclusive and would exist as long as the article to which the design is applied is not reproduced more than 50 times by an industrial process.

13.5 Is copyright available to protect industrial Designs?

As per the provisions of Section 15(2) of the Copyright Act, 1957 “copyright in any design, which is capable of being registered under the Designs Act, but which has not been so registered, shall cease as soon as any article to which the design has been applied, has been reproduced more than fifty times by an industrial process by the owner of the copyright, or, with his licence, by any other person”.

14 Current Developments

14.1 What have been the significant developments in relation to Designs in the last year?

The introduction of comprehensive e-filing system for Indian design applications and related documents has been brought about by the Controller General of Patents, Designs and Trade Marks (CGPDTM), India. The system is fully functional from 1st January 2019 and now the applicants from anywhere in India can use this system to file and manage prosecution of Design applications. This upgraded the filing system and has substantially accelerated the design registration process in India.

14.2 Please list three important judgments in the Designs sphere that have been issued within the last 18 months.

1. **Carlsberg Breweries v. Som Distilleries and Breweries Ltd.:** In a judgment dated 14th December 2018, the Delhi High Court upheld the maintainability of composite suit for design infringement and passing off. A plaintiff can join two causes of action: one for the infringement by the defendant of the plaintiff's design and the second cause of action being of passing off by the defendant of the larger trade dress of the goods/articles as that of the plaintiff, in a composite suit. The judgment has affirmed that remedy for passing off can be brought if the said design is not functioning as a trademark and if the remedy of passing off is claimed for the larger trade dress infringement or any other similar infringement. The court also noted that when the claim for design infringement is *prima facie* weak, on the basis of the same set of facts the court can provide relief to the plaintiff in the form of a passing-off action.
2. **Crocs Inc. USA filed several cases against Bata India Ltd, Relaxo Footwear Ltd, Liberty Shoes Ltd. and Ors. Dated 24th January, 2019:** The Plaintiff – Crocs Inc. – had filed several suits against the infringers and stated that their registered design was infringed upon by various defendants. The suits of design infringement were rejected on the grounds of prior publication. The court came to the conclusion that most of the designs were remarkably similar to the design of the plaintiff. It was also observed that there were minor changes in colour and placement of perforations but all in all the aesthetic effect was the same. However, the defendants stated that the alleged piracy and infringement never occurred as the said

design of the Plaintiff should not have been registered in the first place due to prior publication of similar designs by another entity. The Division Bench in the appeal also noted that there was existence of the Holey Soles' designs in the public domain prior to the design claim of the plaintiff which was based on a similar design. So, the Plaintiff's appeal was dismissed as the registration of the plaintiff's design was not valid due to such prior publication.

3. **M/s Crocs Inc. USA v. Bata India Ltd, Relaxo Footwear Ltd, Liberty Shoes Ltd. and Ors. – Order dated 29th May 2019:** These were six appeals, where applications for interim relief were filed. The appeals were directed against the order dated 18th February 2019 of the single judge who had also dismissed the plaintiff-appellant's suit for passing off as not maintainable. The plaintiff-appellant had filed two sets of suits: one for the infringement of the registered design; and the other for passing off its shape trademark/trade dress. The Division Bench in appeal, after a thorough study of the earlier case precedents in *Mohan Lal v. Sona Paint & Hardware* (2013) 55 PTC 61 (Del) FB and *Carlsberg Breweries v. Som Distilleries and Breweries Ltd.* framed and held the following issue in the affirmative i.e. “whether there can be an availability of remedy of passing off in absence of express saving or preservation of the common law by the Designs Act, 2000 and more so when the rights and remedies under the Act are statutory in nature?” The Court observed that a passing-off action was maintainable along with an action for infringement of a registered design and granted the limited interim relief to the plaintiff on the ground of passing-off against any other parties. Thus, in the interim, the plaintiff was allowed to seek relief to restrain passing off *qua* its registered design used as a trademark/trade dress, get up, presentation of the products through its packaging and so on.
4. In another significant case, **Vega Auto Accessories (P) Ltd v. SK Jain Bros Helmet (I) Pvt. Ltd.**, the Delhi High Court on 1st June 2018 held that the registered proprietor of a design could not use the invalidity or prior publication of the plaintiff's design as a defence in a suit for design infringement. The court noted that once a party has filed an application – claiming that its design is new or original, has not been published before and is distinguishable from known designs – the party cannot oppose the claim for infringement by a prior registrant on the ground that such prior registrant's design is not novel or original. It was thus held that where the plaintiff has prior registration of a design, and the defendant is the registered proprietor of a design that has infringed the registered design of the plaintiff, then the defendant is stopped from pleading invalidity of registration of the plaintiff.

14.3 Are there any significant developments expected in the next year?

The Government of India is proposing to follow the current edition (12th edition) of the Locarno classification as published by the World Intellectual Property Organization (WIPO). The change is proposed to bring the introduction of class 32 of Locarno classification in Design Rules 2001.

Further, there is a proposal to amend Design Rules by incorporating a start-up entity in India recognised by the authority under a start-up initiative and in case of foreign entity, an entity fulfilling the criteria for turnover.

14.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

An electronic filing facility for new design applications has been upgraded to facilitate its better functioning. The Design office is completing the entire process of registration within two to three months in some cases which are straightforward cases of registration. Indian courts regularly deal with design infringement matters and a robust body of case law lays down the established legal principles.



Manisha Singh is a founder and the Managing Partner of the firm. She overviews and supervises all practice groups at the firm. Manisha is known and respected for her deep expertise on prosecution and enforcement of all forms of IP rights and for strategising and managing global patents, trademarks and designs portfolios of large global and domestic companies. Her keen interest in using and deploying the latest technology tools and processes has immensely helped the firm to develop efficient IP service delivery models and to provide best-in-class services. She is also known for her sharp litigation and negotiation skills. She has been involved and successfully resolved various trademarks, copyright and design infringement and passing off cases in short timeframes and in the most cost-efficient manner, applying out-of-box strategies and thinking. She is a member of several international IP associations, such as AIPLA, AIPPI, APAA, ECTA, FICPI, INTA, LESI, MARQUES and actively participates in the committee works of these organisations.

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LexOrbis is a full-service Indian IP firm with offices in New Delhi, Mumbai and Bangalore with over 180 personnel including 91 attorneys. We are ranked amongst the top five IP firms and as the "fastest-growing" IP firm in India. The firm practice is divided into four broad groups: (i) search and analytics; (ii) patent preparation and pros; (iii) trade mark/design/copyright; and (iv) IP enforcement and litigation. The patent practice group has over 61 patent attorneys with expertise in a broad range of engineering and science subjects. The trade mark/design group has over 20 attorneys and they are managing global portfolios of a large number of global and domestic businesses. The IP enforcement and litigation group have 12 seasoned litigators with vast experience. Our professional team members are also avid writers and our articles on the latest IP trends and practices are widely published

on various national and international journals and publications. Our latest blogs can be read on either of the links given here: <https://www.linkedin.com/company/lexorbis-ip-practice/>, Twitter: @LexOrbisIP and <https://www.facebook.com/LexOrbisIP/>.

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